

## REMARKS

In the December 3, 2003 Office Action, claims 1-25 stand rejected in view of prior art. Claims 1-25 also were rejected for failing to indicate and claim particularly and distinctly the subject matter that Applicant regards as the invention.

### *Status of Claims and Amendments*

In response to the December 3, 2003 Office Action, Applicant has amended claims 1, 6-8, 10-13, 15, 16, 18 and 25 as indicated above, cancelled claims 2-5 and 14, and added new claims 26-28. Thus, claims 1, 6-13 and 15-28 are pending, with claims 1 and 8 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

### *Interview Summary*

On April 22, 2004, the undersigned conducted a telephonic interview with Examiner Troy G. Arnold III, who is in charge of the above-identified patent application. Applicant wishes to thank Examiner Arnold for the courteous interview. Basically, the outstanding December 3, 2003 Office Action as well as the pending claims were discussed during the interview. Specifically, the cited combination of references, original claims 5 and 8, and the state of the art generally as well as some possible clarifying amendments were discussed during the interview. More specifically, the undersigned argued that the cited combination of references fails to disclose or suggest first and second banana-shaped pads (i.e. a pair) located in the outer and inner sides of the ankle section, as required by original claims 5 and 8. The undersigned further argued that it is unclear in the prior art where the single arcuate pad is located on the snowboard boot of the Okajima '558 patent. Accordingly, the undersigned argued that the cited combination of references fails to disclose a **boot liner** with banana-shaped pads having strap portions of a tightening device at least partially overlying the banana-shaped pads, as required by original claim 8. Finally, the undersigned suggested deleting the "non-thermoformable" limitation from the claims to overcome the indefiniteness rejection set forth in the Office Action.

Agreement was reached that deleting the "non-thermoformable" limitation from the claims would most likely overcome the indefiniteness rejection set forth in the Office Action. On the other hand, agreement was not reached with respect to the prior art rejections of the claims, particularly original claims 5 and 8. Rather, Examiner Arnold maintained the position of the outstanding Office Action. Thus, the undersigned proposed further amending these claims to

require the thickness of the banana-shaped pads to be larger than the thickness of the thermoformable layer, and/or to further clarify the location and function of the first and second banana-shaped pads to better distinguish the prior art. Agreement was not reached with respect to these proposals. However, Examiner Arnold agreed to further consider such proposals upon submission of a complete Amendment with detailed arguments.

***Claim Rejections - 35 U.S.C. §112***

On page 2 of the Office Action, claims 11 and 12 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. In response, Applicant has amended claims 11 and 12 to clarify that the upper portion includes a foam layer disposed on an interiorly facing side of the thermoformable layer, and that the upper portion includes an outer layer disposed on an exteriorly facing side of the thermoformable layer, respectively. Applicant believes that claims 11 and 12 now fully comply with 35 U.S.C. §112, first paragraph, and withdrawal of this rejection is respectfully requested.

On pages 2 and 3 of the Office Action, claims 1-25 were rejected under 35 U.S.C. §112, second paragraph because the term "non-thermoformable" is allegedly vague and indefinite. In response, Applicant has amended the claims to remove the term "non-thermoformable". Independent claim 1 has been further clarified to require banana-shaped pads constructed of a different material than the thermoformable layer. Applicant believes that the claims now comply with 35 U.S.C. §112, second paragraph, and withdrawal of this rejection is respectfully requested.

On page 3 of the Office Action, as a point of clarification, the Office Action indicates that the terms "inner" and "outer" as in "an inner side and an outer side of said ankle section" are being taken in the context of the disclosure to mean inner and outer with reference to the leg of the wearer, not inner and outer with reference to the shell of the boot liner itself. Applicant agrees with the Office Action on this point of clarification.

***Rejections - 35 U.S.C. § 102***

On pages 3 and 4 of the Office Action, claims 1-4, 9, 10, 12, 13 and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,012,236 (the Pozzobon patent). Claim 11 stands rejected under 35 U.S.C. §102(b) or in the alternative under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent. In response, Applicant has amended independent claim 1 to more clearly define the present invention over the prior art of record.

In particular, independent claim 1 now requires first and second banana-shaped pads located in outer and inner sides of said ankle section, respectively, that are constructed of a different material than the thermoformable layer. Claim 1 further requires the banana-shaped pads to be thicker than the thermoformable layer, to extend laterally towards each other and to be configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer. Clearly, this structure is *not* disclosed by the Pozzobon patent. Rather, the Pozzobon patent basically discloses a layered inner boot with a thermoformable layer 3/103 and a waffle shaped (channeled in a crossed manner to form a checkerboard configuration of projections) second layer 5/105. The Pozzobon patent fails to disclose banana-shaped pads whatsoever. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose each and every element of the claim within the reference.

Accordingly, Applicant respectfully submits that independent claim 1, as now amended, is not anticipated by the prior art of record, and withdrawal of this rejection is respectfully requested. Moreover, Applicant believes that since the prior art of record does not anticipate the independent claim 1, neither does the prior art anticipate the dependent claims 9-13 and 23. Claims 2-4 have been cancelled by the current Amendment. Applicant respectfully requests withdrawal of this rejection.

***Rejections - 35 U.S.C. § 103***

On pages 4-8 of the Office Action, claims 5-8, 14-22, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of references. Specifically,

- (1) Claims 5, 7, 14 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,012,236 (the Pozzobon patent) in view of U.S. Patent No. 6,035,558 (the Okajima '558 patent).
- (2) Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent as applied to claim 5, and further in view of Official Notice.
- (3) Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent as applied to claim 7, and further in view of U.S. Patent No. 5,946,827 (the Okajima '827 patent).
- (4) Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent in view of Official Notice.

- (5) Claims 17-19 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent in view of Dalvy et al. and Donnelly (U.S. Patent Nos. 5,924,218 and 5,893,222, respectively).
- (6) Claims 20-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent as applied to claim 19, and further in view of Official Notice.
- (7) Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Pozzobon patent in view of the Donnelly patent and the Okajima '827 patent.

The Office Action concludes the 35 U.S.C. §103(a) rejections by asserting that a collection of well known features, all doing what they are well known to do, does not necessarily confer patentability. Applicant understands the position of the Office Action. However, Applicant notes that it is well settled in patent law that a unique arrangement of well known features is patentable absent a motivation in the prior art to combine the well known features into the unique arrangement, as claimed. Applicant further notes that a motivation to modify and/or combine prior art references must come from the prior art, not from Applicant's disclosure. Thus, it is improper to use hindsight reasoning (i.e. reasoning based on review of Applicant's disclosure and/or claims) to try to reconstruct the claimed invention from isolated parts of prior art references absent a motivation in the prior art to do so. In other words, Applicant believes that simply because certain features of a claimed invention may be well known individually, this does not render such a combination of features obvious.

In any case, in response, Applicant has amended the claims to more clearly distinguish the various combinations of references cited in the Office Action, as explained below in more detail. In particular, Applicant has amended independent claim 1 as mentioned above, and amended claim 8 to place this claim in independent form and to further distinguish the current prior art of record. Specifically, independent claim 1 now requires first and second banana-shaped pads located in outer and inner sides of said ankle section, respectively, that are constructed of a different material than the thermoformable layer. Claim 1 further requires the *banana-shaped pads to be thicker than the thermoformable layer, to extend laterally towards each other and to be configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer*. Independent claim 8, as now amended, is similar to original claim 8 (rewritten

in independent form), but also now requires first and second ***banana-shaped pads configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer***. Claim 8 already required the upper portion including a tightening device with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of the second banana-shaped pad. Applicant has also now clarified that the upper portion has the tightening device ***fixed thereto***. Clearly these unique arrangements are ***not*** disclosed or suggested by the any of the cited references whether taken alone or in combination, as explained below in more detail.

The Office Action relies upon the Pozzobon patent to disclose the basic structure of the boot liner, as claimed. Furthermore, the Office Action relies upon the Okajima '558 patent to allegedly disclose banana-shaped pads, as claimed. The Office Action further relies upon the Okajima '827 patent to allegedly disclose a tightening device, as claimed. The Office Action relies upon the remaining references cited to allegedly show other features of the dependent claims.

Referring initially to claim 1, which is similar to original claim 5, Applicant believes the Pozzobon patent fails to disclose or suggest the unique arrangement of this claim, as mentioned above. Specifically, the Pozzobon patent basically discloses a layered inner boot with a thermoformable layer 3/103 and a waffle shaped (channeled in a crossed manner to form a checkerboard configuration of projections) second layer 5/105. The Pozzobon patent fails to disclose banana-shaped pads whatsoever. Applicant further believes that the remaining references cited in the outstanding Office Action fail to account for the deficiencies of the Pozzobon patent, as explained below.

Specifically, the Okajima '558 patent discloses a single arcuate pad 170 disposed in the ankle area, discussed at column 4, lines 27-34 of the Okajima '558 patent. Thus, the '558 patent fails to disclose a ***pair of banana-shaped pads*** located in outer and inner sides of said ankle section, respectively, as required by independent claim 1. The thickness and location of the single arcuate pad 170 of the Okajima '558 patent are also unclear. Thus, the Okajima '558 patent also fails to disclose or suggest ***banana-shaped pads thicker than the thermoformable layer*** to extend laterally towards each other and to be ***configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer***, as required by independent claim 1.

The Okajima '827 patent suffers from similar deficiencies. Specifically, the Okajima '827 patent may possibly disclose a single arcuate pad in Figure 1 (shown in broken lines). However, the unnumbered element in Figure 1 of the '827 patent is not discussed at all in the specification. Thus, the Okajima '827 patent also fails to disclose or suggest a pair of ***banana-shaped pads thicker than the thermoformable layer*** to extend laterally towards each other and to be ***configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer***, as required by independent claim 1. The remaining references cited in the Office Action suffer from deficiencies similar to the Pozzobon patent, the Okajima '558 patent and/or the Okajima '827 patent. Thus, the features of independent claim 1 as now amended are clearly not shown in the prior art. Moreover, there is no suggestion or motivation in the prior art to modify any of these references or a combination thereof to result in the present invention.

Referring now to independent claim 8, Applicant believes this claim is allowable for reasons similar to independent claim 1. Specifically, none of the prior art cited in the Office Action discloses a ***pair of banana-shaped pads*** located in outer and inner sides of said ankle section, respectively, that are ***configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint of the wearer***, as required by independent claim 8. Thus, assuming arguendo that it is obvious to add a tightening device to the liner of the Pozzobon patent, it would not result in the claimed invention. However, none of the references cited in the Office Action even disclose a ***boot liner*** with a tightening device ***fixed thereto***, as now required by independent claim 8. Thus, there is no suggestion or motivation in the prior art to modify any of these references or a combination thereof to result in this unique arrangement.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does ***not*** make the modification obvious, unless the prior art ***suggests*** the desirability of the modification. Since the prior art references lack any suggestion or motivation for combining and/or modifying the references as suggested in the Office Action, the conclusion is inescapable that the Office Action relies on impermissible hindsight in an attempt to reconstruct the claimed invention from isolated parts of the numerous prior art references.

Moreover, Applicant believes that the dependent claims 6, 7, 10-13, 15, 16, 18 and 25 are also allowable over the prior art of record in that they depend from independent claim 1 or independent claim 8, and therefore are allowable for the reasons stated above. Also, the

dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in the independent claims, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that these rejections be withdrawn in view of the above comments and amendments.


*New Claims*

Applicant has added new dependent claims 26-28, which depend from independent claims 1 and 8, by the current Amendment. New claims 26-28 are believed to be allowable for the reasons discussed above with respect to the independent claims 1 and 8. New claims 26-28 are further believed to be allowable because they include limitations, which in combination with the independent claims are not disclosed or suggested in the prior art of record.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1, 6-13 and 15-28 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,



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